

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)  
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION

U.S. APPLICATION SERIAL NO. 79223676

MARK: CHEMPIOIL

**\*79223676\***

**CORRESPONDENT ADDRESS:**

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[http://www.uspto.gov/trademarks/teas/response\\_form.jsp](http://www.uspto.gov/trademarks/teas/response_form.jsp)

**APPLICANT:** UAB "SCT Lubricants"

**CORRESPONDENT'S REFERENCE/DOCKET NO.:**

N/A

**CORRESPONDENT E-MAIL ADDRESS:**

**OFFICE ACTION**

**STRICT DEADLINE TO RESPOND TO THIS LETTER**

**INTERNATIONAL REGISTRATION NO. 1076327**

**STRICT DEADLINE TO RESPOND TO THIS NOTIFICATION:** TO AVOID PARTIAL ABANDONMENT OF THE REQUEST FOR EXTENSION OF PROTECTION OF THE INTERNATIONAL REGISTRATION, THE USPTO MUST RECEIVE A COMPLETE RESPONSE TO THIS PROVISIONAL PARTIAL REFUSAL NOTIFICATION **WITHIN 6 MONTHS** OF THE "DATE ON WHICH THE NOTIFICATION WAS SENT TO WIPO (MAILING DATE)" LOCATED ON THE WIPO COVER LETTER ACCOMPANYING THIS NOTIFICATION.

In addition to the Mailing Date appearing on the WIPO cover letter, a holder (hereafter "applicant") may confirm this Mailing Date using the USPTO's Trademark Status and Document Retrieval (TSDR) system at <http://tsdr.uspto.gov/>. To do so, enter the U.S. application serial number for this application and then select "Documents." The Mailing Date used to calculate the response deadline for this provisional partial refusal is the "Create/Mail Date" of the "IB-1rst Refusal Note."

This is a **PROVISIONAL PARTIAL REFUSAL** of the request for extension of protection of the mark in the above-referenced U.S. application that **applies to only the following goods in the application:**

**Class 1:** additives for coolants and for fluids of windscreen washer systems; filtering charcoal; strainers (chemical products, unprocessed plastics, mineral and vegetable substances), ceramic particles as strainers

**Class 3:** car care products, namely, wash preservative agents, paint cleaning products, paint preservative agents in paste form and liquid form; paint waxes; washing shampoos; water repellent agents for vehicle washing equipment; chrome care products; plastic cleaning products; plastic care products; upholstery care products; soaps

**Class 4:** Lubricants; fuels including motor spirit; industrial greases and industrial oils, including engine, transmission, compressor and hydraulic oils; contact oils and contact greases

See 15 U.S.C. §1141h(c). See below in this notification (hereafter "Office action") for details regarding the provisional partial refusal.

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issue(s) below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65(a); TMEP §§711, 718.03.

**SEARCH OF OFFICE'S DATABASE OF MARKS**

The trademark examining attorney has searched the Office's database of registered and pending marks and has found no conflicting marks that would bar registration under Trademark Act Section 2(d). TMEP §704.02; see 15 U.S.C. §1052(d).

**SUMMARY OF ISSUES:**

- Identification of Goods

**IDENTIFICATION OF GOODS**

This requirement applies to all classes.

Some of the wording in the identification of goods is indefinite and must be clarified. See 37 C.F.R. §2.32(a)(6); TMEP §1402.01.

The identification of goods contains parentheses. Generally, applicants should *not* use parentheses and brackets in identifications in their applications so as to avoid confusion with the USPTO's practice of using parentheses and brackets in registrations to indicate goods that have been deleted from registrations or in an affidavit of incontestability to indicate goods not claimed. See TMEP §1402.12. The only exception is that parenthetical information is permitted in identifications in an application if it serves to explain or translate the matter immediately preceding the parenthetical phrase in such a way that it does not affect the clarity or scope of the identification, e.g., "fried tofu pieces (abura-age)." *Id.* Therefore, applicant must remove the parentheses from the identification and incorporate any parenthetical or bracketed information into the description of the goods.

In a Trademark Act Section 66(a) application, classification of goods may not be changed from that assigned by the International Bureau of the World Intellectual Property Organization. 37 C.F.R. §2.85(d); TMEP §§1401.03(d), 1904.02(b). Additionally, classes may not be added or goods transferred from one class to another in a multiple-class Section 66(a) application. 37 C.F.R. §2.85(d); TMEP §1401.03(d).

With respect to Class 1, applicant must clarify the nature of the "filtering charcoal" as other types of charcoal products are classified in other classes. Applicant must also clarify the nature of the "strainers" goods below and incorporate the parenthetical language.

With respect to Class 3, "products" is indefinite and applicant must clarify the type of products in Class 3, as noted below. Applicant must make clear that some of the items below are type of washing preparations in Class 3. The wording "soaps" is overly broad and indefinite, and applicant must specify the type of soaps in Class 3.

With respect to Class 4, applicant must specify the type or use of "lubricants." Applicant must also clarify the nature of the "contact oils and contact greases." In addition, the wording "including" in the identification of goods is indefinite and must be deleted and replaced with a definite term, such as "namely," "consisting of," "particularly," or "in particular." See 37 C.F.R. §2.32(a)(6); TMEP §§1402.01, 1402.03(a). The identification must be specific and all-inclusive. This wording is an open-ended term (e.g., "including," "such as") that is not acceptable because it fails to identify specific services. See TMEP §1402.03(a).

Applicant may adopt the following identification, if accurate:

Class 1: Chemical products for use in industry, in particular chemically and physically active additives for lubricants, greases, industrial oils and for engine, transmission, compressor and hydraulic oils and additives for fuels, in particular petrol and diesel fuels; **Chemical** additives for coolants and for fluids of windscreen washer systems; hydraulic fluids; brake fluids; adhesives used in industry; **{further clarify in Class 1, e.g., charcoal for horticultural purposes}** filtering charcoal; **{further clarify this item and the parenthetical information in Class 1}** strainers (chemical products **{specify type of chemical products or use, e.g., chemicals used in industry}**), unprocessed plastics **in the nature of filtering materials in "Indicate nature of filtering process or industry}**, mineral and vegetable substances **in the nature of filtering materials in {indicate nature of filtering process or industry}**), ceramic particles as strainers **in {indicate nature of filtering process or industry}**

Class 3: Washing and cleaning preparations; cleaning, polishing, scouring and abrasive preparations; cleaning preparations for oil-soiled engines and other soiled industrial objects; cleaning preparations for fuel pipes and injection systems of engines, in particular of motor vehicle engines; car care **preparation products for protecting and preserving vehicle surfaces**, namely, wash preservative agents, paint cleaning products, paint preservative agents in paste form and liquid form; **{further clarify the type of wax in Class 3, e.g., car wax preparations in the nature of}** paint waxes; **{further clarify}** washing shampoos; washing preparations for vehicle washing equipment; powder and liquid pre-washing and washing preparations for steam-jet equipment and high pressure cleaning equipment; **washing preparations in the nature of** water repellent agents for vehicle washing equipment; chrome care products, **namely, {specify in Class 3, e.g., chrome polish}**; plastic cleaning products, **namely, {specify in Class 3}**; impregnating agents and cleaning preparations for motor vehicle folding roofs; plastic care products, **namely, {specify in Class 3}**; **automobile** upholstery care products; wheel rim cleaning preparations; **{specify in Class 3, e.g., non-medicated beauty soap}** soaps.

Class 4: **{further specify use or type, e.g., all-purpose}** Lubricants; dust absorbing, wetting and binding compositions; **fuels, namely, including {further clarify this item}** motor spirit; industrial greases and industrial oils, **including namely**, engine, transmission, compressor and hydraulic oils; **{specify type in Class 4, e.g., lubricating oils, industrial oils}** in the nature of contact oils and contact greases; non-chemical additives for oil, fuels, in particular for petrol and diesel fuels; non-chemical additives for industrial greases, industrial oils, engine oils, transmission oils, compressor oils and hydraulic oils.

Applicant may amend the identification to clarify or limit the goods but not to broaden or expand the goods beyond those in the original application or as acceptably amended. See 37 C.F.R. §2.71(a); TMEP §1402.06. Generally, any deleted goods may not later be reinserted. See TMEP §1402.07(e). Additionally, for applications filed under Trademark Act Section 66(a), the scope of the identification for purposes of permissible amendments is limited by the international class assigned by the International Bureau of the World Intellectual Property Organization (International Bureau); and the classification of goods may not be changed from that assigned by the International Bureau. 37 C.F.R. §2.85(d); TMEP §§1401.03(d), 1904.02(b). Further, in a multiple-class Section 66(a) application, classes may not be added or goods and/or services transferred from one existing class to another. 37 C.F.R. §2.85(d); TMEP §1401.03(d).

For assistance with identifying and classifying goods and services in trademark applications, please see the USPTO's online searchable [U.S. Acceptable Identification of Goods and Services Manual](#). See TMEP §1402.04.

## RESPONSE GUIDELINES

To expedite prosecution of the application, applicant is encouraged to file its response to this Office action online via the Trademark Electronic Application System (TEAS), which is available at <http://www.uspto.gov/trademarks/teas/index.jsp>. If applicant has technical questions about the TEAS response to Office action form, applicant can review the electronic filing tips available online at [http://www.uspto.gov/trademarks/teas/e\\_filing\\_tips.jsp](http://www.uspto.gov/trademarks/teas/e_filing_tips.jsp) and e-mail technical questions to [TEAS@uspto.gov](mailto:TEAS@uspto.gov).

## HOW TO CONTACT & ASSISTANCE

If applicant has questions regarding this Office action, please telephone or e-mail the assigned trademark examining attorney. All relevant e-mail communications will be placed in the official application record; however, an e-mail communication will not be accepted as a response to this Office action and will not extend the deadline for filing a proper response. See 37 C.F.R. §§2.62(c), 2.191; TMEP §§304.01-.02, 709.04-.05. Further, although the trademark examining attorney may provide additional explanation pertaining to the refusal(s) and/or requirement(s) in this Office action, the trademark examining attorney may not provide legal advice or statements about applicant's rights. See TMEP §§705.02, 709.06.

**FAILING TO RESPOND WILL RESULT IN PARTIAL ABANDONMENT OF APPLICATION:** If applicant does not respond to this Office action within the six-month period for response, the goods identified above, in the beginning of this Office action, will be **deleted from the application**.

In such case, the application will then proceed only with the following goods:

**Class 1:** Chemical products for use in industry, in particular chemically and physically active additives for lubricants, greases, industrial oils and for engine, transmission, compressor and hydraulic oils and additives for fuels, in particular petrol and diesel fuels; hydraulic fluids; brake fluids; adhesives used in industry

**Class 3:** Washing and cleaning preparations; cleaning, polishing, scouring and abrasive preparations; cleaning preparations for oil-soiled engines and other soiled industrial objects; cleaning preparations for fuel pipes and injection systems of engines, in particular of motor vehicle engines; washing preparations for vehicle washing equipment; powder and liquid pre-washing and washing preparations for steam-jet equipment and high pressure cleaning equipment; impregnating agents and cleaning preparations for motor vehicle folding roofs; wheel rim cleaning preparations

**Class 4:** dust absorbing, wetting and binding compositions; non-chemical additives for oil, fuels, in particular for petrol and diesel fuels; non-chemical additives for industrial greases, industrial oils, engine oils, transmission oils, compressor oils and hydraulic oils.

See 37 C.F.R. §2.65(a)-(a)(1); TMEP §718.02(a).

**WHO IS PERMITTED TO RESPOND TO THIS PROVISIONAL PARTIAL REFUSAL:** Any response to this provisional refusal must be personally signed by an individual applicant, all joint applicants, or someone with legal authority to bind a juristic applicant (e.g., a corporate officer or general partner). 37 C.F.R. §§2.62(b), 2.193(e)(2)(ii); TMEP §712.01. If applicant hires a qualified U.S. attorney to respond on his or her behalf, then the attorney must sign the response. 37 C.F.R. §§2.193(e)(2)(i), 11.18(a); TMEP §§611.03(b), 712.01. Qualified U.S. attorneys include those in good standing with a bar of the highest court of any U.S. state, the District of Columbia, Puerto Rico, and other U.S. commonwealths or U.S. territories. See 37 C.F.R. §§2.17(a), 2.62(b), 11.1, 11.14(a); TMEP §§602, 712.01. Additionally, for all responses, the proper signatory must personally sign the document or personally enter his or her electronic signature on the electronic filing. See 37 C.F.R. §2.193(a); TMEP §§611.01(b), 611.02. The name of the signatory must also be printed or typed immediately below or adjacent to the signature, or identified elsewhere in the filing. 37 C.F.R. §2.193(d); TMEP §611.01(b).

In general, foreign attorneys are not permitted to represent applicants before the USPTO (e.g., file written communications, authorize an amendment to an application, or submit legal arguments in response to a requirement or refusal). See 37 C.F.R. §11.14(c), (e); TMEP §§602.03-.03(b), 608.01.

**DESIGNATION OF DOMESTIC REPRESENTATIVE:** The USPTO encourages applicants who do not reside in the United States to designate a domestic representative upon whom any notice or process may be served. TMEP §610; see 15 U.S.C. §§1051(e), 1141h(d); 37 C.F.R. §2.24(a)(1)-(2). Such designations may be filed online at <http://www.uspto.gov/trademarks/teas/correspondence.jsp>.

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**TO RESPOND TO THIS LETTER:** Go to [http://www.uspto.gov/trademarks/teas/response\\_forms.jsp](http://www.uspto.gov/trademarks/teas/response_forms.jsp). Please wait 48-72 hours from the issue/ mailing date before using the Trademark Electronic Application System (TEAS), to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail [TEAS@uspto.gov](mailto:TEAS@uspto.gov). For questions about the Office action itself, please contact the assigned trademark examining attorney. **E-mail communications will not be accepted as responses to Office actions; therefore, do not respond to this Office action by e-mail.**

**All informal e-mail communications relevant to this application will be placed in the official application record.**

**WHO MUST SIGN THE RESPONSE:** It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

**PERIODICALLY CHECK THE STATUS OF THE APPLICATION:** To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using the Trademark Status and Document Retrieval (TSDR) system at <http://tsdr.uspto.gov/>. Please keep a copy of the TSDR status screen. If the status shows no change for more than six months, contact the Trademark Assistance Center by e-mail at [TrademarkAssistanceCenter@uspto.gov](mailto:TrademarkAssistanceCenter@uspto.gov) or call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

**TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS:** Use the TEAS form at <http://www.uspto.gov/trademarks/teas/correspondence.jsp>.